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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,501	03/16/2001	Giles Henry Rodway	RK590-US1	3959

7590 01/10/2006

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,501

Applicant(s)

RODWAY, GILES HENRY

Examiner

Kevin R. Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-33,37-40,42,43,46-54,57-71,74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33,37-40,42,43,46-54,57-71,74 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 33, 60, 61, and 64 under 35 U.S.C. 112, second paragraph has been overcome by amendment.

Double Patenting

2. The rejection of claims 28-33, 37-43, 46-54, 57-71, 74, and 75 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. US 6,753,478 has been overcome by argument.

Claim Rejections - 35 USC § 102

3. The rejection of claims 28-33, 37-43, 46-54, 57-71, 74, and 75 under U.S.C. 102(f) has been overcome by argument.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28, 31, 32, 37, 40, 42, 43, 46, 57, 60, 62, and 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,117,118 (herein referred to as Lanza) in view of Hori et al (US 4,049,904).

Lanza teaches an insulated electrical component, advantageously a conductor, preferably a wire, comprising an electrical component at least a portion of which is surrounded by electrical insulation comprising an inner layer comprising a crosslinked

Art Unit: 1773

olefin polymer and an outer layer comprising a crosslinked vinylidene fluoride homopolymer or copolymer (page 1, lines 50+). The olefin polymer may be a polyolefin, for example polyethylene or polypropylene or a copolymer of an olefin with a copolymer such as ethylene with vinyl acetate (page 1, lines 68+). The layers may be crosslinked together through their whole depth (page 2, lines 10+). The layers are applied by extrusion (page 1, lines 59+), which is understood to implicitly teach that the layers are brought into contact with each other "at a temperature above the melting or softening point" of the polymer material in at least one of the layers.

Lanza does not teach that the olefin copolymer should comprise the claimed first polymer comprising "a carbonyl-containing polymer having a non-aromatic backbone and comprising at least 5wt% of repeating units derived from a monomer which can be copolymerized with an olefinic monomer and which contains a carboxylic acid ester." However, Hori teaches a wire comprising a metallic layer adhered to an ethylene unsaturated carboxylic acid ester copolymer (abstract). Suitable esters include ethyl acrylate, propyl acrylate, butyl acrylate, ethyl methacrylate, propyl methacrylate, and butyl methacrylate (col 2, lines 31+). Hori teaches that polymerizing carboxylic acid ester with the ethylene monomers, the adhesion to the metallic layer is improved (col 2, lines 56+). The courts have held that it is not inventive to discover the optimum or workable range by routine experimentation when the general conditions of the claimed invention are disclosed in the prior art (See MPEP 2141.05). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 1773

copolymerize the ethylene taught in Lanza with a sufficient amount of carboxylic acid ester to increase the adhesion of said layer to the metallic conductive layer.

With regard to claims 31, 32, 37, 46, 47, 60, and 67, the examiner takes the position that Lanza reads on said composition wherein the polyethylene content is 0%. Alternatively, Lanza teaches that the middle layer may comprise HDPE (see examples) or an ethylene copolymer. The courts have held that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a composition comprising HDPE and the claimed ethylene-carboxylic acid ester as the intermediate layer of the wire taught in Lanza. The motivation for doing so would have been that Lanza teaches both HDPE and ethylene copolymers are useful as intermediate layer compositions.

With regards to the method limitations of claims 2, 5, 10, and 11, the examiner takes the position that the method of making a product does not patentably distinguish said product from a product taught in the prior art unless it can be shown that the method of making the product inherently results in a materially different product. In the present application, no such showing has been made.

6. Claims 29, 30, 38, 39, 51-54, 58, 59, 63, 71, 74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,117,118 (herein referred to as Lanza) in

view of Hori et al (US 4,049,904), as applied to claims above, and further in view of Vodges et al (US 4,693,940).

Lanza in view of Hori is relied upon as above, but does not teach that the interlayer surfaces of the PVDF should be irradiated. However, Vogdes teaches a method of enhancing the bonding between incompatible polymers in a laminate structure by irradiating the laminate (col 1, lines 63+). The method results in part from chemical crosslinking across the interface between the layers. It is therefore essential that each of the polymeric compositions be radiation crosslinkable. Radiation crosslinking agents are preferably included in the composition to assist in making them radiation crosslinkable and to improve the strength of the bond between the layers (col 2, lines 36+). The crosslinkers are included in one or both compositions (see Tables A and B). The method should be done at such conditions to allow for at least a two-fold increase in the peel strength of the laminate (col 3, lines 41+). Specifically, heat treatment of the laminate should be carried out at a temperature higher than the melting point of at least one, and preferably all of the polymers in each of the compositions (col 3, lines 49+). The method is especially useful in for heat shrinkable tubes, especially for electrical insulation purposes (col 2, lines 51+). It would have been obvious to one of ordinary skill in the art to irradiate the laminate taught by Lanza. The motivation for doing so would have been to improve interlayer adhesion.

With regards to the claimed bond strength and delamination limitations, Vogdes teaches that the amount of bonding is proportional to the conditions in heat treatment and irradiation steps (col 3, lines 41+) as well as the amount of crosslinker present (col

Art Unit: 1773

2, lines 42+). Thus, it would have been obvious to one of ordinary skill in the art to vary the radiation and heat treatment steps as well as the amount of crosslinker present in order to control the adhesive strength of the resulting substrate to the adhesive taught in Lanza.

The examiner further notes that co-extrusion of such wire coatings is common in the art (see Miyaki) and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to coextrude the layers of Lanza because such a method is standard/known in the art.

7. Claims 33, 47, 50, 61, 68, and 70, are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,117,118 (herein referred to as Lanza) in view of Hori et al (US 4,049,904), as applied to claims above, and further in view of Bartoszek (US 4,804,702).

Lanza in view of Vogdes is relied upon as above, but does not teach that the PVDF layer should comprise a copolymer of VDF and hexafluoropropylene. However, Bartoszek teaches a composition comprising a PVDF co-polymer with a hexafluoropropylene of 12wt% (see claim 2) that exhibits improved smoke and flame retardant properties (abstract). Said polymers are especially useful in the wiring industry (col 1, lines 6+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the composition taught in Bartoszek as the PVDF layer taught in Lanza. The motivation for doing so would have been that said composition is flame and smoke retardant.

Art Unit: 1773

8. Claims 48, 49, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,117,118 (herein referred to as Lanza) in view of Hori et al (US 4,049,904) and Vodges et al (US 4,693,940), as applied to claims 28-31, 32, 37-40, 42, 43, 46, 51-54, 57-60, 62-68, and 70 above, and further in view of Bartoszek (US 4,804,702).

Lanza in view of Vodges is relied upon as above, but does not teach that the PVDF layer should comprise a copolymer of VDF and hexafluoropropylene. However, Bartoszek teaches a composition comprising a PVDF co-polymer with a hexafluoropropylene of 12wt% (see claim 2) that exhibits improved smoke and flame retardant properties (abstract). Said polymers are especially useful in the wiring industry (col 1, lines 6+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the composition taught in Bartoszek as the PVDF layer taught in Lanza. The motivation for doing so would have been that said composition is flame and smoke retardant.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773